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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/620,206	07/15/2003	Hiromi Ukai	81940.0054	8718
26021	7590	01/04/2007	EXAMINER	
HOGAN & HARTSON L.L.P. 1999 AVENUE OF THE STARS SUITE 1400 LOS ANGELES, CA 90067			SMITHERS, MATTHEW	
			ART UNIT	PAPER NUMBER
			2137	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/620,206	UKAI ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Matthew B. Smithers	2137	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### **Status**

- 1) Responsive to communication(s) filed on 15 July 2003.
- 2a) This action is **FINAL**.                                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### **Disposition of Claims**

- 4) Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-5,9 and 11-20 is/are rejected.
- 7) Claim(s) 6-8 and 10 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### **Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 15 July 2003 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### **Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### **Attachment(s)**

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No(s)/Mail Date 7/15/03.
- 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application
- 6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Information Disclosure Statement***

The information disclosure statement filed July 15, 2003 has been placed in the application file and the information referred to therein has been considered as to the merits.

### ***Claim Objections***

Claims 5 and 6 are objected to because of the following informalities: Both claims are missing a period. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-5, 9, and 11-20 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. patent application 20010051996 granted to Cooper et al.

Regarding claim 1, Cooper meets the claimed limitations as follows:

"An apparatus that uses digital contents, the apparatus comprising:

    a reception processing section that receives from a provider apparatus a certificate containing a first provider ID embedded therein by a certification authority, and a digital content having a second provider ID embedded therein by a contents guarantee authority;

    a first check processing section that judges by using the certificate as to whether or not the provider is authorized by the certification authority;

    a storage processing section that reads the first provider ID from the certificate, correlates the first provider ID with the digital content, and store the digital content in a recording medium;

    a detection processing section that detects the second provider ID from the digital content; a second check processing section that compares the first provider ID and the second provider ID to judge whether or not the first provider ID and the second provider ID match;

    and a use processing section that uses the digital content according to a decision made by the second check processing section." see Abstract; paragraph [0057]; paragraphs [0065] to [0071]; paragraph [0074]; paragraph [0125]; paragraph [0134] paragraph [0136]; paragraph [0196] and Figures 2, 3, 5, 6 and 7.

Regarding claim 2, Cooper meets the claimed limitations as follows:

"An apparatus according to claim 1, wherein the use processing section restricts the use of the digital content when the second check processing section decides that the first

provider ID and the second provider ID do not match." see paragraph [0074] and Figures 2, 3, 5, 6 and 7.

Regarding claim 3, Cooper meets the claimed limitations as follows:

"An apparatus according to claim 1, wherein the second provider ID is embedded as electronic watermark in the digital content by the contents guarantee authority." see paragraph [0075]; paragraph [0087] and Figures 2, 3, 5, 6 and 7.

Regarding claim 4, Cooper meets the claimed limitations as follows:

"An apparatus according to claim 1, further comprising: a notification processing section that notifies at least one of the certification authority, the contents guarantee authority and a contents holder owning the copyright of the digital content, when the second check processing section decides that the first provider ID and the second provider ID do not match." see paragraph [0074] and Figures 2, 3, 5, 6 and 7.

Regarding claim 5, Cooper meets the claimed limitations as follows:

"An apparatus according to claim 4, wherein the notification processing section notifies at least one of the certification authority, the contents guarantee authority and the contents holder of at least one of the first provider ID and the second provider ID, when the second check processing section decides that the first provider ID and the second provider ID do not match." see paragraph [0074] and Figures 2, 3, 5, 6 and 7.

Regarding claim 9, Cooper meets the claimed limitations as follows:

"An apparatus according to claim 1, wherein the provider apparatus embeds in the digital content a first user ID of a unit that uses the digital content, the recording medium stores a second user ID, the detection processing section detects the first user ID from

the digital content when the second check processing section decides that the first provider ID and the second provider ID match, and the second check processing section compares the first user ID and the second user ID to decide whether or not the first user ID and the second user ID match.” see paragraph [0075]; paragraph [0087]; paragraph [0162] and Figures 2, 3, 5, 6 and 7.

Regarding claim 11, Cooper meets the claimed limitations as follows:  
“An apparatus according to claim 1, wherein the storage medium stores a list of invalid certificates created by the certification authority, and the first check processing section decides that the provider is authorized by the certification authority when a certificate ID of the certificate is not included in the list of invalid certificates.” see paragraphs [0065] to [0071] and Figures 2, 3, 5, 6 and 7.

Regarding claim 12, Cooper meets the claimed limitations as follows:  
“A method for using digital contents, the method comprising the steps of:  
requesting a provider apparatus for a certificate containing a first provider ID embedded therein by a certification authority, and receiving the certificate from the provider apparatus;

deciding by using the certificate as to whether or not the provider is authorized by the certification authority; requesting the provider apparatus for a digital content having a second provider ID embedded therein by a contents guarantee authority when the provider is authorized by the certification authority, and receiving the digital content from the provider apparatus; reading the first provider ID from the certificate;

correlating the digital content with the second provider ID and storing the digital content in a storage medium; detecting the second provider ID from the digital content in response to a request to use the digital content; comparing the first provider ID and the second provider ID when the second provider ID is detected;

using the digital content when the first provider ID and the second provider ID match; and restricting the use of the digital content when the first provider ID and the second provider ID do no match." see Abstract; paragraph [0057]; paragraphs [0065] to [0071]; paragraph [0074]; paragraph [0125]; paragraph [0134] paragraph [0136]; paragraph [0196] and Figures 2, 3, 5, 6 and 7.

Regarding claim 13, Cooper meets the claimed limitations as follows:  
"An apparatus that provides digital contents to a terminal, the apparatus comprising:

a storage device that stores a certificate having a first provider ID embedded therein by a certification authority and a digital content having a second provider ID embedded therein by a contents guarantee authority;

a first transmission processing section that transmits the certificate to the terminal in response to a request from the terminal;

and a second transmission processing section that transmits the digital content to the terminal in response to a request from the terminal, when the terminal decides by using the certificate that the provider is authorized by the certification authority, wherein the terminal compares the first provider ID and the second provider ID to decide whether or not the first provider ID and the second provider ID match, and uses the digital content according to a resultant decision as to whether or not the first provider ID

and the second provider ID match." see Abstract; paragraph [0057]; paragraphs [0065] to [0071]; paragraph [0074]; paragraph [0125]; paragraph [0134] paragraph [0136]; paragraph [0196] and Figures 2, 3, 5, 6 and 7.

Regarding claim 14, Cooper meets the claimed limitations as follows:  
"An apparatus according to claim 13, wherein the storage device stores a first terminal ID of a terminal that is authorized to receive the digital content, and the provider apparatus is equipped with a terminal certification section that requests the terminal for a second terminal ID before the second transmission processing section transmits the digital content to the terminal, and compares the first terminal ID and the second terminal ID to decides as to whether or not the first terminal ID and the second terminal ID match." see Abstract; paragraph [0057]; paragraphs [0065] to [0071]; paragraph [0074]; paragraph [0125]; paragraph [0134] paragraph [0136]; paragraph [0196] and Figures 2, 3, 5, 6 and 7.

Regarding claim 15, Cooper meets the claimed limitations as follows:  
"An apparatus according to claim 14, wherein the second transmission processing section transmits the digital content to the terminal when the terminal certification section decides that the first terminal ID and the second terminal ID match." see Abstract; paragraph [0057]; paragraphs [0065] to [0071]; paragraph [0074]; paragraph [0125]; paragraph [0134] paragraph [0136]; paragraph [0196] and Figures 2, 3, 5, 6 and 7.

Regarding claim 16, Cooper meets the claimed limitations as follows:

"A method for providing digital contents to a terminal, the method comprising the steps of:

storing a certificate having a first provider ID embedded therein by a certification authority and a digital content having a second provider ID embedded therein by a contents guarantee authority;

transmitting the certificate to the terminal in response to a request from the terminal;

and transmitting the digital content to the terminal in response to a request from the terminal, when the terminal decides by using the certificate that the provider is authorized by the certification authority, wherein the terminal compares the first provider ID and the second provider ID to decide whether or not the first provider ID and the second provider ID match, and uses the digital content according to a resultant decision as to whether or not the first provider ID and the second provider ID match." see Abstract; paragraph [0057]; paragraphs [0065] to [0071]; paragraph [0074]; paragraph [0125]; paragraph [0134] paragraph [0136]; paragraph [0196] and Figures 2, 3, 5, 6 and 7.

Regarding claim 17, Cooper meets the claimed limitations as follows:

"An apparatus that uses digital contents, the apparatus comprising:

a storage device that stores a first user ID of a unit that uses a digital content;  
a reception processing section that receives from a provider apparatus a digital content having a second user ID of the unit embedded therein;

a detection processing section that detects the first user ID from the digital content;

a check processing section that compares the first user ID and the second user ID to decide as to whether or not the first user ID and the second user ID match;

and a use processing section that uses the digital content according to a decision of the check processing section." see Abstract; paragraph [0057]; paragraphs [0065] to [0071]; paragraph [0074]; paragraph [0125]; paragraph [0134] paragraph [0136]; paragraph [0196] and Figures 2, 3, 5, 6 and 7.

Regarding claim 18, Cooper meets the claimed limitations as follows:  
"A method for using digital contents, the method comprising the steps of:  
storing a first user ID of a unit that uses a digital content;  
receiving a digital content having a second user ID of the unit embedded therein from a provider apparatus that provides the digital content;  
detecting the first user ID from the digital content;  
comparing the first user ID and the second user ID and deciding as to whether or not the first user ID and the second user ID match;  
and using the digital content according to a decision made in the step of deciding." see Abstract; paragraph [0057]; paragraphs [0065] to [0071]; paragraph [0074]; paragraph [0125]; paragraph [0134] paragraph [0136]; paragraph [0196] and Figures 2, 3, 5, 6 and 7.

Regarding claim 19, Cooper meets the claimed limitations as follows:  
"An apparatus that uses digital contents, the apparatus comprising:

a reception processing section that receives from a provider apparatus a certificate having a first provider ID embedded therein by a certification authority and receives from another provider a digital content having a second provider ID embedded therein by a contents guarantee authority;

a first check processing section that decides by using the certificate as to whether or not the provider is authorized by the certification authority;

a storage processing section that reads the first provider ID from the certificate, correlates digital content with the first provider ID and stores the digital content in a storage medium;

a detection processing section that detects the second provider ID from the digital content; a second check processing section that compares the first provider ID and the second provider ID and decides as to whether or not the first provider ID and the second provider ID match;

and a use processing section that uses the digital content according to a decision made by the second check processing section." see Abstract; paragraph [0057]; paragraphs [0065] to [0071]; paragraph [0074]; paragraph [0125]; paragraph [0134] paragraph [0136]; paragraph [0196] and Figures 2, 3, 5, 6 and 7.

Regarding claim 20, Cooper meets the claimed limitations as follows:  
"A method for using digital contents, the method comprising the steps of:

requesting a provider apparatus for a certificate containing a first provider ID embedded therein by a certification authority, and receiving the certificate from the provider apparatus;

deciding by using the certificate as to whether or not the provider is authorized by the certification authority;

requesting another provider apparatus for a digital content having a second provider ID embedded therein by a contents guarantee authority when the provider is authorized by the certification authority, and receiving the digital content from the other provider apparatus;

reading the first provider ID from the certificate;

correlating the digital content with the first provider ID and storing the digital content in a storage medium;

detecting the second provider ID from the digital content in response to a request to use the digital content; comparing the first provider ID and the second provider ID when the second provider ID is detected;

using the digital content when the first provider ID and the second provider ID match;

and restricting the use of the digital content when the first provider ID and the second provider ID do not match." see Abstract; paragraph [0057]; paragraphs [0065] to [0071]; paragraph [0074]; paragraph [0125]; paragraph [0134] paragraph [0136]; paragraph [0196] and Figures 2, 3, 5, 6 and 7.

***Allowable Subject Matter***

Claims 6-8 and 10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

With respect to claim 6, the cited prior art fails to specifically teach the detection processing section decides that a distribution route of the digital content is outside of a range of management when the second provider ID is not detected from the digital content, and the second check processing section decides that the distribution route of the digital content is illegal when the second check processing section decides that the first provider ID and the second provider ID do not match.

With respect to claim 7, the cited prior art fails to specifically teach the recording medium includes a contents storage section that stores the digital content, and a license management section that has a higher tamper resistance than the contents storage section and stores the first provider ID correlated with a name of the digital content.

With respect to claim 8, the cited prior art fails to specifically teach the detection processing section detects a content ID from the digital content when the detection processing section does not detect the second provider ID from the digital content, and the use processing section permits the use of the digital content when the detection processing section does not detect the content ID from the digital content.

With respect to claim 10, the cited prior art fails to specifically teach the reception processing section requests the provider apparatus for the certificate before requesting

the provider apparatus for the digital content, receives the certificate from the provider apparatus, requests the provider apparatus for the digital content when the first check processing section decides by using the certificate that the provider is authorized by the certification authority, and receives the digital content from the provider apparatus.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

A. Noyama et al (US 2020034305) discloses a system for issuing service to a requesting user based on identification numbers.

B. Lee et al (US 6,950,941) discloses a copy protection system for a portable storage media.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew B. Smithers whose telephone number is (571) 272-3876. The examiner can normally be reached on Monday-Friday (8:00-4:30) EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel L. Moise can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Matthew B. Smithers  
Primary Examiner  
Art Unit 2137